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REMARKS

Claims 1-11, 18-23 are pending. Claims 12-17 and 24-27 have been canceled. No new matter has been added.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

Claims 1-11, 18, 20, and 21 have been amended notwithstanding the belief that these claims were allowable. Any reference herein to "the invention" is intended to refer to the specific claim or claims being addressed herein. The claims of this Application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this Application, except for arguments specifically directed to the claim.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-27 under 35 USC § 103 as obvious from Merriman, et al. (USP 5,948,061) in view of Gerace (USP 5,848,396). This rejection is respectfully traversed.

Merriman is directed to a process for targeting advertising over the Internet (See Merriman, 1:65). Merriman's process includes the following steps, hereinafter referred to as "Merriman Step":

(1) a user, via a web browser, requesting a web page from a web site (See Merriman, 3: 24-28);

(2) the web site providing to the user's browser:

(a) the web page but omitting an advertisement section of the web page (See Merriman, 3:28-34), and

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(b) a link including (i) the IP address of an advertiser server
(See Merriman, 3:36-37) and (ii) information about the web page
(See Merriman, 3:37-38);

(3) the user's web browser transmits the link and the user's IP address to the
IP address of the advertiser server (See Merriman, 3: 41-45);

(4) the advertiser server selects which advertisement to send to the user's
browser (See Merriman, 3:51-54);

(5) the advertiser server sends to the user's browser the selected
advertisement for insertion in the web page originally requested (See Merriman,
3:54-56);

(6) if the user clicks on the advertisement within the web page, then

(a) the user's web browser sends a message to the advertiser
server indicating that the user clicked on the advertisement (See
Merriman, 3:64-67), and

(b) the advertiser server notes that the user clicked on the
advertisement (See Merriman, 3:67-4:2), and

(c) the advertiser server sends to the user's browser
instructions for the user's browser to contact the URL for the
advertiser's web page (See Merriman 4:3-5).

Gerace is directed to a process for tracking and profiling user behavior with regard to agate
information (time sensitive, reference material such as telephone listings, classified advertisements,
weather reports, sports scores and statistics, market data, books and recordings) and providing

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customized agate information and targeted advertisements to the users based on the user's psychographic and demographic profile. (See Gerace, 1:8-12, 2:1-15, 2:24-29).

"To establish a *prima facie* case of obviousness, [...] the prior art reference (or references when combined) must teach or suggest all the claim limitations." *MPEP 706.02(j)*. Even if, in arguendo, the features of Merriman and Gerace were combinable, they would still fail to teach each and every feature of the claimed invention.

Claim 1:

Claim 1 is independent. Claim 1 recites, among other features, "the client application transmitting a notification signal to the online server notifying the online server that the user clicked on the advertisement." The Examiner contends that Merriman (1:28-45, the ABSTRACT, FIG. 1, FIG. 3A, and 1:6-11) inherently shows the claimed feature because "transmitting notification signals was common practice in, for example, handshaking signals used in computer networking/communications at the time of the invention." The Practitioner believes that the Examiner's interpretation of "notification signal" is unreasonably broad and beyond the scope of the specification. Claim interpretation is only reasonable if it is "consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990), *In re Academy of Science Tech Center*, 2004 U.S. App. LEXIS 9382, 7(Fed. Cir. 2004). The specification at page 34, lines 14-21, shows that the notification signal is sent when the user clicks on the advertisement. Moreover, "[t]he notification signal preferably includes an advertisement identification code that the OSP server . . . uses to identify the advertisement on which the user clicked. The notification signal also includes a user identification code that identifies the user that clicked on the advertisement." This is now reflected in the currently amended claim 1. The Examiner's construction of the claimed notification signal as a common handshaking signal is not supported in the cited portion of Merriman. Therefore, Merriman does not teach or suggest the claimed feature.

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Claim 1 recites, among other features, “the online server using the personal profile information to identify one or more resource locators according to a selection protocol associated with the advertisement.” The Examiner contends that Merriman (1:28-45, the ABSTRACT, FIG. 1, FIG. 3A, and 1:6-11) shows the claimed feature. Although Merriman, at 1:28-45, identifies a resource locator in response to a click-through, the cited portion of Merriman does not identify the resource locator using the personal profile information according to a selection protocol associated with the advertisement. Although Merriman’s ABSTRACT discusses display of advertisements based upon profiling, the cited portion of Merriman does not select one or more resource locators in response to a click through of an advertisement. Although Merriman’s FIG. 3A is relevant to profiling, it does not teach or suggest the claimed feature. Although Merriman, at 1:6-11, generically discusses targeted internet advertisements, it does not teach or suggest the claimed feature. Therefore, the cited portion of Merriman does not teach or suggest the claimed feature.

Moreover, since the cited portion of Merriman does not teach or suggest “the online server using the personal profile information to identify one or more resource locators according to a selection protocol associated with the advertisement,” it follows, logically, that the cited portion of Merriman does not teach or suggest the claimed features, “the online server transmitting a signal to the client application identifying the one or more resource locators” and “the client application causing the local device to access one or more resources associated with the one or more resource locators.”

The Examiner contends that Merriman’s “*affiliate*” (see Merriman FIG. 1) is interpreted as a sponsor. In fact, the advertiser associated with the advertiser’s web site is analogous to the sponsor. (See Merriman Step 6 and Merriman Step 6(c) above.) The specification describes an analogous step at page 10, lines 13-15: “[w]henver a user clicks-through on an advertisement, the client application initiates a process whereby the user-related information is passed to the advertisement’s sponsor.” Moreover, the specification at page 27, lines 14-15 describes that “[a] sponsored advertisement comprises an advertisement that an online service provider displays in the client window [. . .] on

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behalf of a sponsor.” Since the Merriman Step (6) shows that the advertiser, not the affiliate, is analogous to the specification’s sponsor, the Examiner’s interpretation of “*affiliate*” to be a sponsor is incorrect.

In light of the Examiner’s arguments, claim 1 has been amended, as follows, to include features not taught nor suggested in Merriman or Gerace:

A method of providing an advertisement-related electronic presentation to a user of an online service, and tracking user response, the user using a client application on a local device to access an online server associated with the online service, wherein the online service displays an advertisement to the user on behalf of a sponsor, the method comprising:

the client application establishing and managing a connection from a local device to an online server of the online service, wherein the client application is not a browser application;

during establishing the connection, the client application displaying a locally stored advertisement;

the online server obtaining, from the client application, geographic location data and personal profile information from associated with the user;

the online server creating a play list based on the geographic location data and the personal profile information, wherein the play list includes a plurality of ad objects and an order of display, each ad object including a first resource locator associated with an advertisement, a second resource locator associated with a click-through of the advertisement, and a display time for the advertisement;

the online server sending the play list to the client application;

the client application causing ~~an~~ the advertisements associated with the play list to be displayed on the local device in the order of display;

if the user clicks on a cycle back icon, the client application causes the

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previously displayed advertisements to be displayed in reverse order;

the client application transmitting a notification signal to the online server notifying the online server that the user clicked on the one of the advertisements, wherein the notification signal includes an advertisement identifier code associated with the one of the advertisements and a user identifier code associated with the user;

the online server using the personal profile information associated with the user and the advertisement identifier code to identify ~~one or more~~ a third resource locators according to a selection protocol associated with the one of the advertisements;

As amended, claim 1 now includes features which are neither taught nor suggested by Merriman in view of Gerace. Therefore, claim 1 is now in form for allowance. It is respectfully requested that the rejection now be withdrawn.

Claims 2, 3:

By virtue of dependence from claim 1, claims 2 and 3 are patentable for the same reasons as presented for claim 1.

The preamble of claims 2 and 3 have been amended to reflect the currently amended preamble of claim 1.

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Claim 4:

Claim 4 is independent. To the extent that claim 4 has features similar to claim 1, the arguments set forth for claim 1 are applicable to claim 4. Therefore, claim 4 is patentable over Merriman, in view of Gerace for the same reasons as set forth in claim 1.

In light of the Examiner's arguments, the claim 4 has been amended, as follows, to include features not taught nor suggested in Merriman or Gerace:

A method of providing a sponsor access to click-through data related to an advertisement that is displayed to a user of an online service administered by an online service provider, the user using a client application on a local device to access an online server associated with the online service, the local device including an input device and an output device, wherein the online service display the advertisement to the user on behalf of a sponsor, the method comprising:

~~the client application activating;~~

the client application causing the advertisement to be displayed on the output device;

the client application monitoring if the user performs a click-through on the advertisement, wherein the client application is not a browser application;

the user performing a click-through on the advertisement;

the client application creating a data set, the data set including an identifier code associated with the advertisement and further including information descriptive of the user and locally storing a click-through record, the click-through record including the time the user performed the click-through, the date the user performed the click through, geographic location data of the local device, an advertisement identifier code associated with the advertisement, a user identifier code associated with the user, and a sponsor identifier code associated with the sponsor;

the client application transmitting the data set click-through record to the

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online server via a communication channel from the local device to the online server;

the client application receiving one or more resource locators based on a selection protocol associated with the advertisement, personal profile information associated with the user, and the advertisement identifier code;

the online server storing the ~~data-set~~ click-through record in a format that is accessible by the sponsor.

Claim 4, in current form, includes the feature, "the online server storing the ~~data-set~~ notification signal in a format that is accessible by the sponsor." As discussed in the arguments for claim 1, "notification signal" is not taught nor suggested by Merriman, in view of Gerace.

As amended, claim 4 now includes features which are neither taught nor suggested by Merriman in view of Gerace. Therefore, claim 4 is now in form for allowance. It is respectfully requested that the rejection now be withdrawn.

Claims 5-11:

By virtue of dependence from claim 4, claims 5-11 are patentable for the same reasons as presented for claim 4.

The preamble of claims 5-11 have been amended to reflect the currently amended preamble of claim 4.

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Claim 18:

Claim 18 is independent. Claim 18 recites, among other features, “the user providing the client application with data descriptive of the user, wherein the data includes the user’s name, address, occupation, marriage status, and age.” The Examiner contends that Merriman (2:6-36, FIG. 2, FIG. 3A, FIG. 3B, FIG. 3C, 1:25-45, and 2:1-5) shows the claimed feature. Merriman, at 2:6-36, discusses that information about networks is routinely collected, that information is gathered when a user clicks on an advertisement, and then provides a general summary of Merriman Steps (1) – (6) above. Merriman, at 2:6-36, does not show the claimed feature, “the user providing the client application with data descriptive of the user, wherein the data includes the user’s name, address, occupation, marriage status, and age.” Merriman’s FIG. 2 discloses that there is a database, but does not show what is in the database. Therefore, Merriman’s FIG. 2 does not show the claimed feature. Merriman’s FIG. 3A, 3B, and 3C show fields of a database. However, none of the claimed feature, “user’s name, address, occupation, marriage status, and age” are shown in the fields of Merriman’s FIG. 3A, 3B, or 3C. The Examiner contended that Gerace shows “marital status.” Even if the Practitioner concedes this proposition, the Examiner has still not shown where Merriman shows the user’s name or address of the claimed feature. Merriman, at 1:25-45, describes a standard click-through process and does not discuss data descriptive of the user. Merriman, at 2:1-5, generically states the object of Merriman’s invention, “to gather information about recipients of the advertisement.” However, FIG. 3A, 3B, and 3C show that the information Merriman gathers is not the information of the claimed feature. Therefore Merriman, in view of Gerace does not teach or suggest the claimed feature.

Since Merriman, in view of Gerace, does not teach or suggest the claimed “user-descriptive data,” it follows, logically, that Merriman cannot teach or suggest the claimed features, “the client application storing the user-descriptive data in a first data set,” and “the client application transmitting the user-descriptive data to an online server associated with the online service via a communication channel linking the local device to the online server.” Moreover, Merriman, at 2:6-

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36, shows that data is transferred to the ad server, not the online server.

In light of the Examiner's arguments, the claim 18 has been amended, as follows, to include features not taught nor suggested in Merriman or Gerace:

A method of assembling data related to a user's interaction with an advertisements, the user accessing an online service via a local device and a client application, the local device including an input device and an output device, the method comprising:

the user providing the client application with data descriptive of the user, wherein the data includes the user's name, address, occupation, marriage status, and age, gender, state, country, zip code, income, education level, hobbies, family size, sports interests, and musical interests;

the client application locally storing the user-descriptive data in a first data set;

the client application causing an advertisement to be displayed on the output device;

the user using the input device to perform a click-through on the advertisement;

the client application creating and locally storing a click-through record, the click-through record including the time the user performed the click-through, the date the user performed the click through, geographic location data of the local device, an advertisement identifier code associated with the advertisement, the user-descriptive data, and a sponsor identifier code associated with the sponsor;

the client application transmitting the ~~user-descriptive data~~ click-through record to an online server associated with the online service via a communication channel linking the local device to the online server;

~~the online server storing the user-descriptive data in a second data set, wherein the second data set includes an advertisement identifier code that identifies~~

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~~the advertisement on which the user performed a click through.~~

As amended, claim 18 now includes features which are neither taught nor suggested by Merriman in view of Gerace. Therefore, claim 18 is now in form for allowance. It is respectfully requested that the rejection now be withdrawn.

Claims 20, 21:

By virtue of dependence from claim 18, claims 20 and 21 are patentable for the same reasons as presented for claim 18.

In light of the Examiner's arguments, the claims 20 and 21 have been amended, as follows, to include features not taught nor suggested in Merriman or Gerace:

Claim 20 (Currently amended): The method of assembling data related of claim 18, further comprising the online service provider provides the sponsor with the information contained within the ~~second data set~~ click-through record.

Claim 21 (Currently amended): The method of assembling data related of claim 19, wherein the online service provider provides the sponsor with the information contained within the ~~second data set~~ click-through record via an electronic medium.

As amended, claims 20 and 21 now includes features which are neither taught nor suggested by Merriman in view of Gerace. Therefore, claims 20 and 21 are now in form for allowance. It is respectfully requested that the rejection now be withdrawn.

Claims 19, 22, and 23:

By virtue of dependence from claim 18, claims 19, 22, and 23 are patentable for the same reasons as presented for claim 18.

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Conclusion

It is submitted, however, that the independent and dependant claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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